

REMARKS/ARGUMENTS

I. Rule 105 Requirement

The Examiner indicated that an issue of public use or on sale activity had been raised. The Examiner requested that the Applicant provide evidence for why FPMS Grape Program Newsletter (Oct., 2001) and the Hashim article dated Nov./Dec., 2001 were not public use or an offer for sale. The Examiner listed four specific questions on page 3 of the office action for which additional information was requested.

1. The Examiner asked for the relationship of the FPMS, UC Office of Technology Transfer (OTT) and California Foundation.

Both FPMS and the OTT are wholly-owned divisions of the University of California (i.e., the assignee of the present application). The role of FPMS (also referred to as "FPS" or "Foundation Plant Services") include producing, testing, maintaining and distributing premium disease-tested plant propagation material for the University; providing plant importation, quarantine, disease testing, virus elimination, and DNA ID testing services; maintaining and coordinating release of UC-patented grape, fruit and nut tree, and strawberry cultivars and acting as a link between researchers, nurseries and producers in the California agricultural industry. Thus, FPMS receives plant varieties developed at the University of California and tests them for pathogen and pest contamination. FPMS only provides University of California plants to licensed nurseries with consent of OTT.

The OTT directs prosecution of plant patents for the University of California and also licenses patented varieties to nurseries.

"California Foundation" refers a level of certification for plant varieties. In this context, "Foundation" describes a level of plant material in the commercialization process. In the seed industry, "Foundation" is the earlier stage to "Certified" and "Registered" level seed. "Foundation" material is the primary source material (usually directly derived from the original plant created by the breeder) for vegetatively propagated plants. All progeny released by the University are derived from "Foundation" plants.

2. The Examiner asked whether the claimed cultivar was donated to the FPMS public collection based on page 2 of the FPMS newsletter.

The claimed variety has never been available directly to the public through FPMS without approval of OTT. As discussed above, the earliest release of the plants to nurseries by FPMS occurred on August 27, 2003.

The only release of the variety earlier was by the breeder who provided several parties the rootstock on July 28, 2003 under a test agreement which, among other things, did not allowed for communication to third parties or propagation of the varieties.

3. The Examiner asked whether FPMS had sold or given the claimed cultivar to California Foundation in 2002 for stock plants.

As discussed above, "California Foundation" does not refer to an entity, but instead is a level of certification of the propagating material. Thus, FPMS did not sell or give the cultivar to "California Foundation."

4. The Examiner alleged that page 4 of the FPMS newsletter suggested that by contacting the OTT the claimed cultivar was available for sale to nurseries for propagating the variety.

The section of the newsletter referred to by the Examiner is not an offer for sale. The portion of the newsletter referred to by the Examiner states the following: "The UC Office of Technology Transfer (OTT) is working to develop patents for 'RS-3' and 'RS-9'. Nurseries interested in becoming licenced [sic] to propagate these varieties should contact Melissa Kimball at OTT phone...."

First of all, the variety was not released to nurseries more than a year before the filing date of the present application. Therefore, the release is not relevant under 35 U.S.C. § 102(b), which is directed to public use or sales more than a year before the filing date.

Second, the above-language does not amount to an offer for sale as required by the patent laws. For example, according to the Federal Circuit, "[o]nly an offer which rises to

the level of a commercial offer for sale, one which the other party could make into a binding contract by simple acceptance (assuming consideration), constitutes an offer for sale under §102(b)." *Group One Ltd. v. Hallmark Cards, Inc.*, 59 USPQ2d 1121, 1126 (Fed. Cir. 2001).

The language in the FPMS newsletter is in no way a binding contract for sale. Instead, it merely states that interested parties could contact Melissa Kimball at the OTT to license the variety. The OTT did not offer any specific information regarding licensing that would amount to an offer that could be binding by mere acceptance as required by the Federal Circuit. Accordingly, the language referenced by the Examiner was not an offer for sale.

On page 4 of the Office Action, the Examiner also stated that it appeared that the claimed cultivar was in public use at "PCA" farm as early as 2001, based on page 1 of the Hashim article. The Examiner appears to have mis-read the article. First, "PCA" does not refer to a farm, but instead is an abbreviation for "pest control advisor." The 'RS-9' plants referred to were on University of California property when they were analyzed for a viral grape disease that occurred in 2001. It should be noted that the author of the article is a University of California cooperative extension specialist, i.e., a University employee. The reference to 'RS-9' in the article refers to the "UCCE Princess rootstock trial" which was apparently an analysis of various new grape rootstocks. Since the observations were made on University property by a University employee, the Hashim article does not describe a "public use".

II. Oath/Declaration

The Examiner noted that the oath was defective because it did not refer to asexual reproduction of the claimed variety. Applicants thank the Examiner for noting this issue. A new oath with the correct information is enclosed.

III. Objection to the disclosure

The Examiner objected to the disclosure on a number of points. For convenience, Applicants have responded in the order presented by the Examiner.

A. Single quotation marks have been inserted around the cultivar names in the substitute specification as requested by the Examiner.

B. As amended, the specification in paragraph [4] indicates where and how the plants were asexually reproduced.

C. Age and growing conditions are now provided in paragraph [14] in the substitute specification.

D. The Examiner request that Applicants indicate how 'RS-9' differs from its parents. Applicants respectfully refer the Examiner to paragraphs [43] and [55] of the substitute specification. Applicants have amended these paragraphs to add additional differences.

E. The genus names of *Xiphenema index* and *Pratylenchus vulnus* were inserted in paragraph [12].

F. Paragraph [14] has been amended to correct the inadvertent reference to 'RS-3'.

G. Applicants note that a description of the trunk is not normally used in grape variety or species identification because of differences due to exposure and weathering. Also, rootstock vines are often headed just above the soil level and have little exposed trunk. Nevertheless, what description was possible has been inserted at paragraph [29].

H. The Examiner requested photographs of the "bine," fruit and flowers.

Applicants assume that the Examiner intended to write "vine". As Applicants provided three photographs of 'RS-9' that included the vine, it is not clear what additional aspect must be photographed. Applicants respectfully request that the Examiner clarify or withdraw the request.

'RS-9' is a male plant. Therefore no fruit is produced to be photographed.

It is Applicant's understanding that the flowers of male plants are not usually considered useful descriptors as they are developing and in a state of flux between bud break and bloom and then abscise at bloom. The specification in paragraphs [21-22] currently contains a description of the flowers. Accordingly, Applicants request withdrawal of the objection.

I. The Examiner asked what the recitation "0-0-2-0-2-0-2" referred to. A numbering sequence for tendrils is often used in ampelographic descriptions. The 0-0-2-0-2-0-2 sequence refers to "intermittent tendrils", when there are never more than 2 nodes in succession

with tendrils which are interrupted with 1 node without a tendril. The 2 zeros at the beginning indicate that the base of the shoot begins with at least 2 nodes without tendrils.

J. Paragraph [020] is amended to describe the color of the tendrils.

K. The information regarding flowers was inserted at [21-22] to the best of Applicants ability. Applicants note that 'RS-9' plants does not produce complete flowers; they only contain male parts. No fruit is produced. The lengths of pedicels and peduncles therefore is not applicable.

L. $P \leq 0.25$ refers to the ratio of height/width of the serrations. "P" is an ampelographic term first described by the French. In this case the serrations are "very shallow" with a height:width of $\leq 1:4$ or ≤ 0.25 . To clarify this in the specification, the section has been amended to read " $P \leq 0.25$ (height/width of serrations) (U.P.O.V. – 6.1.29/1)".

M. Mature shoot color has been amended in the specification to include reference to the color chart.

N. The average shoot length is 105.5 inches. This is because the shoots continue to grow all season along trellis wires and the ground. Shoot length is not a reliable descriptor due to potential differences in growing conditions and support wires. Therefore, Applicants have not inserted this information into the specification.

O. As discussed above, 'RS-9' is male and therefore does not produce fruit. Accordingly, the specification has not been amended to describe the characteristics requested for "O".

P. The claims has been amended as requested by the Examiner.

In view of the above remarks and the substitute specification, Applicants respectfully request withdrawal of the objections.

IV. Rejection under 35 USC § 112, first and second paragraphs

The Examiner rejected claim 1 under 35 USC § 112, first and second paragraphs. In view of the above remarks and the substitute specification, Applicants respectfully request withdrawal of the rejections.

Appl. No. 10/656,533
Amdt. dated December 7, 2004
Reply to Office Action of August 17, 2004

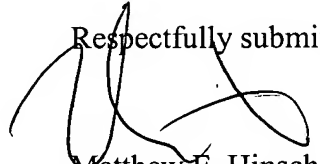
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CONCLUSION

In view of the foregoing, Applicants believe the claim now pending in this Application is in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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